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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,140	02/16/2001	Takuji Tanimura	04791/0134	2146
22428	7590	07/15/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			KADING, JOSHUA A	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 07/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,140

Applicant(s)

TANIMURA, TAKUJI

Examiner

Joshua Kading

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

Figure 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are
5 required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings
10 will not be held in abeyance.

Claim Objections

Claim 13 is objected to because of the following informalities:

Claim 13, line 3 states "maintenance/operation". It is not clear if applicant means
15 "maintenance or operation" or "maintenance and operation". It is suggested that applicant changes claim 13, line 3 to --maintenance or operation-- or --maintenance and operation--.

Appropriate correction is required.

20

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply
5 with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 13 states "the central control unit integrates the call control, service control, maintenance [and] operation service." The only place in the specification where
10 "service control" and "maintenance and operation" is mentioned is on page 9, lines 15-18. It is not clear however, what "service control" and "maintenance and operation" consist of. As such, how could one of ordinary skill integrate these into the control unit if it is not clearly defined in applicant's specification what is meant by "service control" and "maintenance and operation"?

15

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20

Claims 3, 4, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

25

Claims 3 and 4 recite the limitation "the IP address information" in line 6 of both claims. It is unclear which IP address information applicant is referring to as there is the

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control unit IP address (as disclosed earlier in the claim) and there is the IP address of the telephone sets and gateway (as in independent claims 1 and 2).

As in the 35 U.S.C. 112 first paragraph rejection, it is not clear what "service control" and "maintenance and operation" of claim 13 consist of. The specification does not clearly and distinctly define these terms.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S. Patent 6,252,952 B1) in view of Nelson et al. (U.S. Patent 6,741,705 B1) and in further view of White et al. (U.S. Patent 6,069,890).

Regarding claims 1 and 2, Kung discloses "a hybrid type telephony system capable of establishing a connection between conventional type telephone sets contained in an exchange unit..., the system comprising:

a gateway circuit connected between the exchange unit and the IP network (figure 1, the gateway block in element 120 is connected between the IP network 120 (which uses switches and routers to transport data) and the exchange 160),

and a central control unit connected to the LAN of the IP network (figure 1, element 200 and figure 2 shows a detailed schematic of the control unit 200) for establishing a communication path to the exchange unit via a control bus (col. 26, lines 65-col. 9, lines 1-12), controlling switching of IP packets of the IP network (figure 2, element 210), managing IP address information of the LAN type telephone sets and the gateway circuit via the LAN (figure 2, element 214 where it is known in the art that KNS servers manage and store the IP address (and other address) information for call management), and controlling connection between the LAN type telephone sets and connection between the LAN type telephone sets and the gateway circuit (figure 2, element 218 which is fully explained for call setup and management in col. 25, lines 58-col. 28, lines 1-9)."

However, Kung lacks what Nelson discloses, "... LAN type telephone sets contained in an IP network (figure 1, elements 22)..." Kung and Nelson further lack what White discloses, "a gateway circuit...performing voice data format conversion (figure 7, element 208 is a voice recognition card which is known to receive analog voice signals and convert them into a digital format for further processing and transmission, it is note that element 104 is the gateway pictured in figure 4)..."

It would have been obvious to one with ordinary skill in the art at the time of invention to include the IP telephones and the voice format conversion with the rest of the systems of claims 1 and 2 for the purpose of communicating using a traditional voice phone and IP voice phone (White, col. 11, lines 34-40). The motivation for this is

an IP based telephone system can accommodate more users (and thus more calls) because it is a connectionless oriented system.

Since claims 3 and 4 are not clear as to which IP address line 6 of each claim is referring to, it is assumed applicant intended this to represent the IP address of the central control unit and will be treated as such.

Regarding claims 3 and 4, Kung, Nelson, and White disclose the systems of claims 1 and 2. However, White lacks what Kung and Nelson further disclose, "the LAN type telephone sets (figure 1, elements 22) have IP address information of the central control unit (col. 25, lines 58-62 where the gateway (not the residential gateway, but the gateway as described in claims 1 and 2) used in the IP network is directly connected to the control unit and the IP telephones and thus must have the IP address of the control unit so that it may send/receive data), upon call to one of the LAN type telephone sets, transmits a call requesting packet to the central control unit via the LAN according to the IP address information (col. 26, lines 27-29 where the dialed digits represent a call request), inquires the central control unit about a destination IP address, and fetches the destination IP address to establish communication (col. 26, lines 29-35 where the routing number is the destination IP address)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the call request and the retrieving of IP address information with the systems of claims 1 and 2 for the same reasons and motivation as in claims 1 and 2.

Regarding claims 5 and 6, Kung, Nelson, and White disclose the systems of claims 3 and 4. However, White lacks what Kung and Nelson further disclose, "upon connection between one of the LAN type telephone sets (figure 1, elements 22) and one of the conventional type telephone sets, the central control unit reports the IP address of the gateway circuit to the LAN type telephone set (col. 25, lines 58-61 where the LAN type telephone (IP telephone) must have known the gateway circuit IP address in order to access the control unit because, as seen in figure 1, the control unit is only accessible through the IP network gateway) and the IP address of the LAN type telephone to the gateway circuit (col. 26, lines 41-45 whereby issuing a call proceeding message to the IP telephone, so as to establish a communication path between the conventional telephone set and the gateway circuit (where the IP telephone is accessed through the residential gateway) means the control unit was informed of the IP telephones IP address)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the IP address notification with the systems of claims 3 and 4 for the same reasons and motivation as in claims 3 and 4.

Regarding claims 7-12, Kung, Nelson, and White disclose the systems of claims 1 and 2, 3 and 4, and 5 and 6. However, Kung lacks what White and Nelson further disclose, "the central control unit assigns a single extension representation telephone number for the plurality of conventional type telephone sets (col. 10, lines 28-30 where the conventional telephone(s) extension is the "*82") and the plurality of LAN type telephone sets (figure 1, elements 22) as a single group (col. 10, lines 30-33 where the

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LAN type telephone sets (the "voice capable computer") is represented by "*83") and, upon call from one of the conventional telephone sets or the LAN type telephone sets using the extension representation telephone number, performs a call-incoming processing to all the telephone sets in the group (col. 10, lines 28-36 although "*82" is not talked about, it is implied that to access the conventional telephones, the "*82" would be dialed to initiate communication)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the prefix dialing with the systems of claims 1-6 for the same reasons and motivation as in claims 1-6.

10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (703) 305-0342. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Joshua Kading
Examiner
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June 28, 2004



KENNETH VANDERPUYE
PRIMARY EXAMINER